

## REMARKS

## Status of the Claims

Claims 1-45 are pending in the application, Claims 1, 16, and 28 having been amended to more clearly define the present invention, and Claims 7, 12, 29, 34 and 45 having been amended to correct a punctuation error (i.e., adding an omitted period) and other minor grammatical and/or typographical errors.

## Claim Objections

The Examiner has objected to Claims 13-15, 27, and 43 as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner has indicated that applicants should cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. The Examiner asserts that the infringement test for determining a proper dependent claim as per the MPEP 608.01 (n), Section 3, states that such a claim cannot conceivably be infringed by anything that would not also infringe the claim it references. In this case a computer memory medium would not infringe the methods steps of Claims 1, 16, or 39 since the memory medium itself never actually performs any of the active steps required by Claims 1, 16 and 39. In other words, possession of such a memory medium would infringe Claims 13 through 15, 27, and 43, but not Claims 1, 16, and 39, respectively. Thus the Examiner concludes Claims 13 through 15, 27, and 43 are improper dependent claims.

First, applicants note that Claim 13 does not recite a memory medium. Thus, applicants believe this objection of Claim 13 was never intended to be encompassed by the Examiner's objection of Claims 14-15, 27 and 43. Accordingly, applicants respectfully request that the Examiner withdraw his objection to Claim 13.

Second, Claims 14-15 depend from independent method Claim 1, Claim 27 depends from independent method Claim 16 and Claim 43 depends from independent Claim 39. Dependent Claims 14-15, 27, and 43 properly further limit the patentable subject matter of Claim 1, 16, and 39, respectively, because they recite that a computer readable medium is employed for storing computer-executable instructions that perform the method steps of Claim 1, 16, and 39, respectively. This type of dependent claim form (referred to as a “Beauregard claim” based on a related case by that name, as noted below) has been used in hundreds of issued software invention related patents, and the Examiner is urged to consult his Supervisory Examiner to discuss the

1 acceptance of this form of claiming subject matter. Subject matter of this type was determined to  
2 be patentable by the Court of Appeals for the Federal Circuit, based upon the decision reported in  
3 the case, *In re Beauregard*, 35 USPQ2d 1383.

4 Claims 14-15, 27, and 43 are clearly dependent claims because they refer to and are based  
5 upon independent method Claims 1, 16, and 39. As such, they cannot be infringed without  
6 infringing the base method claims. The recitation of Claims 14-15, 27 and 43 further limit the  
7 steps recited in method Claims 1, 16, and 39, by requiring that the steps be performed by executing  
8 computer-executable instructions that are stored on a computer readable medium. As stated in the  
9 preamble of applicants' Claims 1, 16, and 39, the claims are directed towards a method for  
10 initiating an action in regard to a document, a method for automating actions in a document and a  
11 method for specifying actions that will be carried out in a document in response to a text entry,  
12 respectively. The steps of Claims 1, 16, and 39 are not directed towards using the computer  
13 medium. Claims 14-15, 27, and 43 simply provide further recitation that explains that computer-  
14 executable instructions for performing the steps of the method are stored on a computer readable  
15 medium. The same result could have been achieved by drafting Claim 15 to read, for example:  
16 "The method of Claim 1 further comprising the step of providing computer-executable instructions  
17 stored on a computer readable medium for carrying out steps (a), (c), and (d)," but that form of  
18 claiming is unnecessary. The U.S. Patent and Trademark Office long ago determined that the  
19 current form of Claims 14-15, 27 and 43 are acceptable. Accordingly, the Examiner is asked to  
20 withdraw the objection of Claims 14-15, 27, and 43.

21 Claims Rejected under 35 U.S.C. § 102(e)

22 The Examiner has rejected Claims 1-2, 5-7, and 13-15 as being anticipated by Allen et al.  
23 (U.S. Patent No. 6,026,410 hereinafter referred to as "Allen"). The Examiner asserts that Allen  
24 describes each element of applicants' claim recitation. Applicants respectfully disagree for the  
25 reasons noted below.

26 In the interest of reducing the complexity of the issues for the Examiner to consider in this  
27 response, the following discussion focuses on independent Claims 1, 16, 28, 39, and 44. The  
28 patentability of each dependent claim is not necessarily separately addressed in detail. However,  
29 applicants' decision not to discuss the differences between the cited art and each dependent claim  
30 should not be considered as an admission that applicants concur with the Examiner's conclusion that

1 these dependent claims are not patentable over the cited references. Similarly, applicants' decision  
2 not to discuss differences between the prior art and every claim element, or every comment made by  
3 the Examiner, should not be considered as an admission that applicants concur with the Examiner's  
4 interpretation and assertions regarding those claims. Indeed, applicants believe that all of the  
5 dependent claims patentably distinguish over the references cited. However, a specific traverse of the  
6 rejection of each dependent claim is not required, since dependent claims are patentable for at least  
7 the same reasons as the independent claims from which the dependent claims ultimately depend.

8 Discussion of the Rejection of Independent Claim 1

9 Significant differences exist between the recitation in applicants' Claim 1 and the teachings of  
10 Allen. For example, Allen does not appear to teach or suggest the recitation by applicants of an  
11 "action," such as recited in step (b), "...each of the plurality of tags having an *action* associated with  
12 it," or as recited in step (d), "automatically carrying out the *action* associated with said at least one  
13 tag, wherein the *action* exhibits at least one behavior in the document."

14 Applicants' Step (b) and Step (d) in Claim 1

15 The Examiner has asserted that Allen discloses applicants' step (b). Step (b) recites in its  
16 entirety "providing a plurality of tags, each of the plurality of tags having an action associated with  
17 it." The Examiner has asserted that Allen discloses "trigger" and "keyword identifiers" and cites  
18 Allen, column 12, lines 13-45, and Figure 12.

19 The Examiner has also asserted that Allen discloses applicants' step (d). Step (d) recites in its  
20 entirety "automatically carrying out the action associated with said at least one tag, wherein the  
21 action exhibits at least one behavior in the document." The Examiner asserts that Allen displays a  
22 link and opening a selected object (Allen, column 7, lines 16-44 and Figure 4A-4B, Figure 5-7).

23 The Examiner has not been specific, but even if, *arguendo*, the Examiner were correct in  
24 asserting that (1) Allen's "keyword identifiers" are equivalent to applicants' claim recitation of "the  
25 plurality of tags," and (2) Allen's "trigger" is equivalent to applicants' claim recitation of "an action,"  
26 it is clear that Allen still does not disclose or teach the recited functionality of applicants' plurality of  
27 tags.

28 First, it is not clear to applicants from Figure 12 whether the Examiner is indicating that the  
29 term "keyword identifiers" corresponds to the words found in Trigger table 856 or to words found in  
30 Keyword Dictionary 852, in Allen. If the Examiner intended that "keyword identifiers" correspond

1 to the words or tokens found in the trigger table, it should be noted that these words or tokens have *no*  
2 *action associated* with them, and therefore, fail to meet the recitation by applicants in step (b) of  
3 Claim 1. Figure 10 of Allen discloses that if the token is determined to be a trigger as found by  
4 comparing the token to trigger table 856, the trigger is appended to a keyword buffer, but this step of  
5 appending is not equivalent to having an action associated with a plurality of tags, as recited by  
6 applicants in step (b).

7 In addition, while Allen discloses that a keynote may be classified as an “action,” or as an  
8 “action request,” Allen does not teach or suggest that an action is *automatically* carried out (Allen,  
9 column 5, lines 37-40). So it appears that the Examiner is incorrectly asserting that “displaying a link  
10 and opening a selected object” is equivalent to applicants’ step (d), since Allen’s teaching does not  
11 correspond to carrying out an action automatically.

12 Second, if the Examiner is asserting that “keyword identifiers” correspond to the keywords  
13 found in keyword dictionary 852, and that the action associated with the keyword dictionary is that of  
14 displaying a link and opening a selected object, applicants again respectfully disagree that Allen  
15 teaches or suggests any action that is automatically carried out. Applicants’ specification discloses  
16 that an action is automated to exhibit behaviors in a document (page 5, line 26.) For example, the  
17 action may cause an entry related to the text entry by the user to be made in a defined portion of the  
18 document (page 6, line 23-24). Furthermore, applicants specification discloses that “Many other  
19 types of actions can also be implemented besides simply inserting text within a spreadsheet cell. For  
20 example, specific types of actions might include printing a document, copying a portion of the  
21 document to a different document, or almost any other action that can be implemented using VB  
22 script or other Code” (page 22, lines 22-27). In contrast, as described in Allen as shown in Figure 12,  
23 the definition link of keyword dictionary 852 links with the keyword definitions 854 to form output  
24 structured information. But this portion of Allen does not teach that any action is automatically  
25 carried out. To clarify this distinction, applicants have amended step (d) to recite that the action is  
26 *automated*, and that the action *exhibits a behavior* in the document.

27 Alternatively, if the Examiner intended to assert that Allen’s “trigger” is equivalent to  
28 applicants’ recitation of a “plurality of tags” and that Allen’s “keyword identifiers” are equivalent to  
29 applicants’ recited “action,” it does not appear that Allen teaches or suggests that an “action”  
30 associated with a plurality of triggers is carried out. The Examiner’s citation is reproduced below:

Object dictionary 851 includes a trigger table 856, a keyword dictionary 852, and keyword definitions table 854. Trigger table 856 includes entries called *triggers* for each of the tokens from which keywords are formulated. Associated with each trigger is a reference count identifying the number of keywords of which the corresponding trigger is a member. Keyword dictionary 852 includes the identity of each of the keywords pre-defined using methods or calls provided by the keyword parser of keyword and date/time parser 810. Blocks 1210, 1212, and 1214 shown in FIG. 12 illustrate three examples of calls to an "add keyword" function or method used to add an entry to keyword dictionary 852. These calls are also used to load keyword definition information into keyword definition table 854. As shown in the examples in FIG. 12, keyword definitions include a reference to a list object, a project object, and a contact object associated with each keyword in the keyword dictionary 852. **The keyword dictionary 852 includes a definition link (Def. Link) which points to the keyword definition entry corresponding to the keyword in the keyword dictionary 852.** As a result of the sample method calls 1210, 1212, and 1214 illustrated in FIG. 12, keyword dictionary 852, keyword definition table 854, and trigger table 856 are populated with keywords and associated keyword definitions and triggers. Once these tables and storage areas of object dictionary 851 are populated, the keyword parser of keyword and date/time parser 810 can be used to parse a user input keynote from a natural language form including these predefined keywords into an output structured information table containing the linked list objects, project objects, and contact objects associated to the keywords detected by the keyword parser of keyword and date/time parser 810 in the user input keynote (Emphasis added, Allen, column 12, lines 13-45).

However, at least two aspects of applicants' claim recitation regarding "an *action*" are not even suggested by Allen. Specifically, Allen does not teach or suggest that: (1) an action is associated with each of the plurality of tags; or (2) any such action is automatically carried out. If the Examiner is asserting that because Allen teaches "a keyword identifier is associated with each of the plurality of triggers" corresponds to an action that is associated with a plurality of tags, then Allen must also teach or disclose that the keyword identifier is automatically carried out. In other words, the correspondence between the element of Allen that the Examiner cites as being equivalent to applicants' action must follow through applicants' other recitation in the claim regarding an action. Instead, the Examiner indicates that displaying a link and opening a selected object corresponds to an action being carried out. However, as the above citation from Allen indicates, the trigger is part of trigger table 856, and as is apparent from Figure 12, there is no action associated with the table. Allen discloses that a reference count is associated with each trigger and this reference count identifies the number of keywords of which the corresponding trigger is a member. But Allen does not teach or suggest that an action is associated with each trigger.

1       Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 102(e) over Allen  
2 should be withdrawn, for the reasons given above, since Allen does not teach or suggest all of the  
3 recitation of independent Claim 1.

4       Claims 2, 5-7, and 13-15 ultimately depend from independent Claim 1. Because dependent  
5 claims inherently include all of the steps or elements of the independent claim from which the  
6 dependent claims ultimately depend, dependent Claims 2, 5-7 and 13-15 are patentable for at least the  
7 same reasons discussed above with regard to independent Claim 1. Accordingly, the rejection of  
8 dependent Claims 2, 5-7 and 13-15 under 35 U.S.C. § 102(e) over Allen should be withdrawn.

9 Claims Rejected under 35 U.S.C. § 103(a)

10      The Examiner has rejected Claims 3-4 and 10 under 35 U.S.C. § 103(a) as being unpatentable  
11 over Allen and further in view of Goldberg et al. (U.S. Patent No. 5,651,107, hereinafter referred to  
12 as “Goldberg”).

13      In addition, the Examiner has rejected Claims 8 and 9 under 35 U.S.C. § 103(a) as being  
14 unpatentable over Allen and further in view of Budzinski et al. (U.S. Patent No. 5,715,468,  
15 hereinafter referred to as “Budzinski”).

16      Furthermore, the Examiner has rejected Claims 11-12, 39-41, and 43 under 35 U.S.C.  
17 § 103(a) as being unpatentable over Allen and further in view of Ho et al. (U.S. Patent No. 5,836,771,  
18 hereinafter referred to as “Ho”).

19      Also, the Examiner has rejected Claims 16-18, 20-21, 23-24, 27-30, 32-33, and 35-36 as  
20 being unpatentable over Allen and further in view of Kanaegami et al. (U.S. Patent No. 5,297,039,  
21 hereinafter referred to as “Kanaegami”).

22      The Examiner has rejected Claims 22, 25, 34, and 37 as being unpatentable over Allen in  
23 view of Kanaegami, and Budzinski.

24      The Examiner has rejected Claim 42 as being unpatentable over Allen in view of Ho and  
25 further in view of Goldberg.

26      The Examiner has rejected Claim 44 as being unpatentable over Goldberg, in view of Carter  
27 et al. (U.S. Patent No. 6,108,619, hereinafter referred to as “Carter”).

28      The Examiner has rejected Claim 45 as being unpatentable over Goldberg, in view of Carter  
29 and further in view of Fukao et al. (U.S. Patent No. 5,323,311, hereinafter referred to as “Fukao”).  
30      Applicants respectfully disagree with these rejections for the reasons noted below.

1        Discussion of the Rejection of Independent Claim 16

2            Independent Claim 16 is directed towards a method for automating actions in a document,  
3 based upon text entered in the document by a user. The Examiner has asserted that Allen discloses  
4 applicants' step(d) and step (e) because Allen displays a link and opens a selected object and he cites  
5 column 7, lines 16-44 and Figures 4A, 4B, 5,6 and 7 in support of his assertion. However, for the  
6 reasons explained above, Allen does not teach or suggest automatically causing an action associated  
7 with said instance to be implemented. And Kanaegami also fails to teach the aspects of applicants'  
8 claim recitation discussed above. Accordingly, the rejection of independent Claim 16 under  
9 35 U.S.C. § 103(a) over Allen and further in view of Kanaegami should be withdrawn, for the  
10 reasons given above, since Allen and Kanaegami do not teach or suggest all of the recited steps of  
11 independent Claim 16.

12           Claims 17-27 ultimately depend from independent Claim 16. Because dependent claims  
13 inherently include all of the steps or elements of the independent claim from which the dependent  
14 claims ultimately depend, dependent Claims 17-27 are patentable for at least the same reasons  
15 discussed above with regard to independent Claim 1. Accordingly, the rejection of dependent  
16 Claims 17-27 under 35 U.S.C. § 103(a) over Allen and further in view of Kanaegami should be  
17 withdrawn.

18        Discussion of the Rejection of Independent Claim 28

19           Independent Claim 28 is directed towards a system for automating actions in a document,  
20 based upon text entered in the document by a user and includes functions (d)(v) that is similar to step  
21 (d)(v) of independent Claim 16. Therefore, for the reasons discussed above, Allen and none of the  
22 other art cited teaches or suggests automatically causing an action to be automatically implemented.

23           Accordingly, the rejection of independent Claim 28 under 35 U.S.C. § 103(a) over Allen and  
24 further in view of Kanaegami should be withdrawn, for the reasons given above, since Allen and  
25 Kanaegami do not teach or suggest all of the recited steps of independent Claim 28.

26           Claims 29-38 ultimately depend from independent Claim 28. Because dependent claims  
27 inherently include all of the steps or elements of the independent claim from which the dependent  
28 claims ultimately depend, dependent Claims 29-38 are patentable for at least the same reasons  
29 discussed above with regard to independent Claim 28. Accordingly, the rejection of dependent  
30

1 Claims 29-38 under 35 U.S.C. § 103(a) over Allen and further in view of Kanaegami should be  
2 withdrawn.

3 Discussion of the Rejection of Independent Claim 39

4 Independent Claim 39 is directed towards a method for specifying actions that will be carried  
5 out in a document in response to a text entry by a user in the document, by returning a tag  
6 corresponding to the text. For the reasons discussed above in connection with independent Claim 1,  
7 which are also pertinent to the recitation of Claim 39, step (e) “that the actions associated with said  
8 one of the tags is carried out in the document,” Allen does not teach or suggest all of the elements of  
9 this claim. The Examiner also asserts that Allen discloses applicants’ step(c) and cites column 12,  
10 lines 5-45 and Figure 12. In its entirety, step (c) recites “storing the tags and actions associated with  
11 the tags for the template in a catalog that is maintained at a site centrally accessible over a network by  
12 each of a plurality of users.” Applicants do not see any portion of either Figure 12 or the citation as  
13 reproduced above, wherein Allen (or any portion of Ho) that teaches or suggests a catalog being  
14 maintained at a site centrally accessible over a network by each of a plurality of users. Accordingly,  
15 the rejection of independent Claim 39 under 35 U.S.C. § 103(a) over Allen and further in view of Ho  
16 should be withdrawn, for the reasons given above, since Allen and Ho do not teach or suggest all of  
17 the recited steps of independent Claim 39.

18 Claims 40-43 ultimately depend from independent Claim 39. Because dependent claims  
19 inherently include all of the steps or elements of the independent claim from which the dependent  
20 claims ultimately depend, dependent Claims 40-43 are patentable for at least the same reasons  
21 discussed above with regard to independent Claim 39. Accordingly, the rejection of dependent  
22 Claims 40-43 under 35 U.S.C. § 103(a) over Allen and further in view of Ho should be withdrawn.

23 Discussion of the Rejection of Independent Claim 44

24 Independent Claim 44 is directed towards a system on which are specified actions that will be  
25 carried out in a document in response to a text entry by a user in the document, by returning a tag  
26 corresponding to the text.

27 The Examiner asserts that Goldberg teaches the functionality of applicants’ step (c)(i) that  
28 recites “enabling the tags and actions associated with the tags to be centrally maintained,” since  
29 Goldberg teaches maintaining tags and metadata at a central data repository. The Examiner cites  
30

1 column 4, line 56-column 5, line 3 and Figure 1, element 20 in support of his assertion. The citation  
2 at column 4-column 5 of Goldberg is reproduced below:  
3

4 With reference to FIG. 1 of the drawings, there is provided a system diagram  
5 according to the present invention of a user scenario-based navigational and document  
6 retrieval system 10. System 10 is adaptable for access by at least one user 12 having  
7 access to at least one computer 14 which has a keyboard 16 for entering the search  
8 criteria as taught by the present invention and a display monitor 18. System 10 also  
9 includes a database or document repository 20 having a plurality of documents stored  
10 therein (best shown in FIGS. 2 and 6). As discussed further herein, each document has  
11 assigned to it a set of *predetermined tags* and preferably at least one corresponding  
12 *predetermined value* for each tag (*defined as metadata 23*). These tags and values  
13 define the parameters by which each document is searchable in repository 20.  
14 (Emphasis added, Goldberg, column 4, lines 56-column 5, line 3.)  
15

16 Applicants respectfully disagree that Goldberg's metadata is equivalent to actions. The above  
17 citation defines metadata as a predetermined value. But a predetermined value is not equivalent to  
18 applicants' action, for the reasons already discussed.

19 Accordingly, the rejection of independent Claim 44 under 35 U.S.C. § 103(a) over Goldberg  
20 and further in view of Carter should be withdrawn, for the reasons given above, since Goldberg and  
21 Carter do not teach or suggest all of the recited aspects of independent Claim 44.  
22

23 Claim 45 ultimately depends from independent Claim 44. Because dependent claims  
24 inherently include all of the steps or elements of the independent claim from which the dependent  
25 claims ultimately depend, dependent Claim 45 is patentable for at least the same reasons discussed  
26 above with regard to independent Claim 44. Accordingly, the rejection of dependent Claim 45 under  
27 35 U.S.C. § 103(a) over Goldberg in view of Carter and in view of Fukao should be withdrawn.  
28

29 Discussion of the Rejection of Dependent Claims 3-4, and 8-12  
30

31 Claims 3-4 and 8-12 ultimately depend from independent Claim 1. Because dependent claims  
32 inherently include all of the steps or elements of the independent claim from which the dependent  
33 claims ultimately depend, dependent Claims 3-4 and 8-12 are patentable for at least the same reasons  
34 discussed above with regard to independent Claim 1. Accordingly, the rejection of dependent  
35 Claims 3, 4 and 10; and 8 and 9; and 11 and 12 under 35 U.S.C. § 103(a) over Allen and in view of  
36 Goldberg; and Allen in view of Budzinski; and Allen in view of Ho, respectively, should be  
37 withdrawn.  
38

In view of the Remarks set forth above, it will be apparent that the claims in this application define a novel and non-obvious invention, and that the application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

Salem K. Moustafa

Sabrina K. MacIntyre  
Registration No. 56,912

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## MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on December 5, 2005.

Date: December 5, 2005

Christine A. Lues